

GP-303275

REMARKS

Claims 1-14 are pending in the present application. Applicants appreciate the indication that Claims 8-14 stand allowed. The Specification has been corrected for two typographical errors. As a result, paragraph [0018] was corrected to match the Figures. No new matter has been introduced by these amendments.

Reconsideration and allowance of the claims is respectfully requested in view of the above amendments and the following remarks.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1 and 7 stand rejected under 35 U.S.C. § 102(b), as allegedly anticipated by US Patent No. 6,279,701 B1 to Namuduri et al. (hereinafter "Namuduri"). Applicants respectfully traverse this rejection.

Claim 1 is directed to a magnetorheological damper comprising a cylindrically shaped housing; a magnetorheological fluid disposed in the cylindrically shaped housing; a piston assembly disposed within the cylindrically shaped housing in sliding engagement with the cylindrically shaped housing defining a first chamber and a second chamber, wherein the piston assembly comprises a plurality of cylindrically shaped fluid passageways extending from the first chamber to the second chamber, and at least one electromagnet; and a power supply in electrical communication with the at least one electromagnet. Claim 7 is dependent upon Claim 1 and further comprises a third chamber defined by a second floating piston and an end of the housing, wherein the third chamber is filled with an inert gas.

Namuduri is generally directed to a damper comprising of a plurality of concentric mounted flux rings around the circumference of a piston core. The piston assembly includes a plurality of substantially annular flow gaps positioned between two flux rings or a flux ring and piston core. Thus, the damper comprises a plurality of substantially annular flow gaps to provide damping.

GP-303275

To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Bariant, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1007 (1988).

Namuduri fails to anticipate Claims 1 and 7 because Namuduri fails to disclose a piston assembly comprising of a plurality of cylindrically shaped fluid passageways extending from the first chamber to second chamber. In Namuduri, the piston assembly includes a plurality of substantially annular flow gaps formed between flux ring and piston core or between flux rings. As such, the fluid passageways as defined by Namuduri are annular shaped not cylindrically shaped as claimed by Applicants. This is clearly shown and described in Namuduri's application in relation to Figure 4B. There is no disclosure of plurality of cylindrically shaped fluid passageways extending from the first chamber to the second chamber as claimed by Namuduri.

Accordingly, the rejection of Claims 1 and 7 is requested to be withdrawn for at least this reason.

Claim Rejections Under 35 U.S.C. § 103(a)

Claim 2 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Namuduri. Applicants respectfully traverse this rejection.

Claim 2 depends from Claim 1, and as such, is directed to a piston assembly comprising, *inter alia*, a plurality of cylindrically shaped fluid passageways extending from a first chamber to a second chamber.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

GP-303275

Applicants traverse the rejection on grounds that Namuduri fails to establish a *prima facie* case of obviousness against independent Claim 2. A *prima facie* case against Claim 1 has not been established because the cited reference fails to teach or suggest a plurality of cylindrically shaped fluid passageways extending from the first chamber to the second chamber. For reasons discussed above, Namuduri discloses and suggests a piston assembly having annular shaped fluid passageways. This is markedly different in terms of function and assembly of a piston assembly comprising a plurality of cylindrically shaped fluid passageways as claimed by Applicants.

In view of the foregoing, the rejection is requested to be withdrawn for at least this reason.

Claim Rejections Under 35 U.S.C. § 103(a)

Claim 6 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Namuduri in view of Munning et al (hereinafter "Munnnng"). Applicants respectfully traverse this rejection.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness, i.e., that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants first traverse the rejection on the grounds that Namuduri in view of Munnnng fails to establish a *prima facie* case of obviousness against independent Claim 6 because the cited references, individually or in combination, fail to teach or suggest, *inter alia*, a piston assembly comprising a plurality of cylindrically shaped fluid passageways having a diameter that decreases from the first chamber to the second chamber. In Namuduri, there is no disclosure or suggestion of cylindrically shaped fluid passageways. As taught and suggested by Namuduri, the shape of

GP-303275

the passageways are annular and appear to be of a constant diameter as shown in Figures 2, and 4A. Munning fails to compensate for these deficiencies. For example, Munning fails to teach a cylindrically shaped fluid passageway extending from the first chamber to a second chamber. Rather, the passageways 131 taught by Munning are trapezoidally shaped.

Secondly, there is no motivation to combine the cited references. Munning is not directed to a magnetorheological damper. There is no disclosure of magnetorheological fluids. Rather, Munning employs a throttle member electromagnetically controls the dimensions of the cross sectional passages of the piston and thus, the hydraulic pressure of fluid flowing through the passageways to provide damping. A finding of "obvious to try" does not provide the proper showing for an obviousness determination. The requirement for a determination of obviousness is that "both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure" (emphasis added). *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). An Examiner, then, cannot base a determination of obviousness on what the skilled person in the art might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do.

Accordingly, the rejections are requested to be withdrawn for at least this reason.

Claim Objection

Claims 3-5 are objected to as being dependent upon a rejected base Claim 1. Applicants respectfully traverse this objection.

Claim 1 should not be rejected because it is not anticipated by Namuduri. The remarks of why Claim 1 should not be rejected are located under Claim Rejection Under 35 U.S.C. §102(b).

Thus Claims 3-5 do not need to be rewritten in independent form.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

GP-303275

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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